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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on August 22, 2001

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~whichever~~ whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-62 ☐ are pending in the application.
Of the above, claim(s) 6-62 ☒ are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-5 ☐ are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number)
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received:

☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2 and 3
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

OFFICE ACTION ON THE FOLLOWING PAGES--

09/741,437

U.S. GPO: 1998-404-498/4051

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DETAILED ACTION

Claims 1-62 are pending in the application.

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-5 in Paper No. 5 is acknowledged. The traversal is on the ground(s) that Applicant alleges that the restriction requirement is improper since the reasons which have been offered by the Examiner do not appear to apply with respect to Groups I-V. Applicant states that under MPEP 808.02, restriction is proper if: (1) each distinct subject has attained recognition in the art as a separate subject by separate classification; (2) each distinct subject has attained recognition in the art as a separate subject even though classified together; or (3) the separate subject matter would require a different field of search. Applicant alleges that it would not pose a serious burden to examine claims 1-31. Applicant argues that if the product claim is found allowable, the inventions of Groups II-V

should be recombined. Applicant also argues that the classes and subclasses are all assigned to the Examiner's art unit.

All of Applicant's arguments have been considered but have not been found persuasive. Section 121 provides the Commissioner of Patents and Trademarks with the authority to restrict applications to several claimed inventions when those inventions are found to be independent and distinct.

In the instant application, the Examiner has determined that several independent and distinct inventions are claimed in the application. In the restriction requirement found in the previous Office Action, it is shown that the invention of Group I, for example, is classified in a different class than the invention of Group II. Moreover, the product as claimed can be used in methods other than claimed by Applicant (ie., as a herbicide). Therefore, it has been established that separate search considerations are required. It would impose undue burden on the Examiner and the Patent Office's resources to examine this application in its entirety. Further, Groups II-V will not be rejoined

since the product claims are not allowable, see below. Additionally, Applicant is incorrect by stating that the classes and subclasses are all assigned to the Examiner's art unit. Class 514, for example, is assigned to a different art unit.

The requirement is still deemed proper and is therefore made FINAL.

Claims 6-62 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5.

It is suggested that in order to advance prosecution, the non-elected subject matter be canceled when responding to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what is meant by the phrase “active truncated derivatives thereof” found in claim 5. Therefore, this phrase should be deleted.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(a) as being anticipated by Moloney et al. {J. Med. Chem., July 15, 1999, Volume 42, pages 2504-2526 - on 1449 Form}.

Moloney et al. disclose compounds 78 and 79 on page 2508 which are embraced by the instant invention.

Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by:

A) Imbach et al., CA 60:2923b, 1964 {CA Registry Number 97359-06-3} – on 1449 Form;

- B) Wakabayashi et al., JP 52083686 {for instance, Examples 1, 30, etc. on pages 880 and 882, respectively} ;
- C) GB 1,503,244 {for instance, Example 1(A) on page 6} ;
- D) Liao et al., CA 102 :6312, 1985 {CA Registry Number 92763-94-5} - on 1449 Form ;
- E) Jamieson et al., U.S. Pat. 4,230,709 {for instance, Example 8 in column 5} – on 1449 Form ;
- F) Takai et al., U.S. Pat. 4,668,683 {for instance, Example No. 24 in columns 17 and 18};
- G) Lopez Rodriquez et al., WO 96/06846 {for instance, CA Registry Number 178481-97-5} – on 1449 Form ; and
- H) Lopez-Rodriquez, J. Med. Chem., May 23, 1997, Volume 40, pages 1648-1656 {see, for instance, Compound 1a in Table 1 on page 1650} - on 1449 Form.

Each of the above cited references disclose products which are embraced by the instant claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakabayashi et al. {JP 52083686}, GB 1,503,244, Jamieson et al. {U.S. Pat. 4,230,709}, Takai {U.S. Pat. 4,668,683} and Lopez Rodriquez {WO 96/06846}.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicant claims hydantoin products. Each of Wakabayashi et al. (page 877), GB 1,503,244 (page 2, Formula I), Jamieson et al. (column 1, Formula I), Takai et al. (columns 13-18) and Lopez Rodriquez (pages 1 and 2) teach hydantoin products which are structurally similar to the instant claimed products.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The indiscriminate selection of “some” among “many” is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (ie., treating central nervous system disorders).

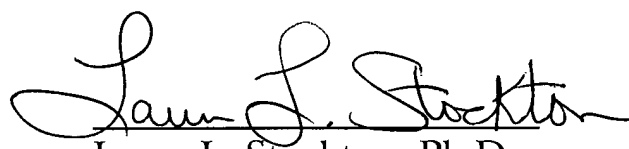
Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

One skilled in the art would thus be motivated to prepare compounds embraced by the reference genera to arrive at the instant claimed products with the expectation of obtaining compounds which would be useful, for example, in treating central nervous system disorders. Therefore, the instant claimed invention would have been suggested to one skilled in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton, Ph.D. whose telephone number is (703) 308-1875.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or 305-3592.

A handwritten signature in black ink, reading "Laura L. Stockton". The signature is fluid and cursive, with the first name "Laura" and last name "Stockton" clearly distinguishable.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

September 10, 2001